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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,126	11/30/2001	Yuichi Takegawa	381NP/50668	8206

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EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/980,126	TAKEGAWA, YUICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheyne D. Ly	1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) 14,15,17-20 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,16 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13-24 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicants' arguments filed October 25, 2004 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Claims 14, 15, 17-20, and 22-24 have been withdrawn, as discussed in the previous Office Action, mailed June 25, 2004.
3. Applicant noted that withdrawn claims 14 and 15 have also been amended and they belong to the same group of claims 13, 16, and 32. Applicant further noted that claims 14 and 15 should also be examined on the merits. It is noted that the amendment to claims 14 and 15 is not directed to the limitations which causes said claims to be distinct from the elected specie. Therefore, claims 14 and 15 have been withdrawn due to being directed to species other than the elected species of an unspecified type of method or system for accepting commission production of DNA chips.
4. It is further noted that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. However, as discussed below, claims 13, 16, and 21 are not in condition for allowance. Therefore, the instant examination has not been extended to withdrawn claims 14 and 15.

5. Claims 13, 16, and 21, an unspecified type of method or system for accepting order and sales for DNA chips, are examined on the merits.

### **OBJECTION**

6. The abstract of the disclosure is objected to because said abstract has more than 150 words. Correction is required. Applicant is required to submit a new abstract on a separate sheet. See MPEP § 608.01(b).

### **RESPONSE TO ARGUMENT**

7. Applicant argues that the Abstract does not have more than 150 words which is not persuasive because the instant Abstract has 154 words, which is more than 150.

### **IDS**

8. Applicant submits PCT/JP01/00683, Exhibit I, as an English copy of the ISR (Item AQ of the previously filed IDS). It is noted that document AQ has been interpreted as a web document which is different from the PCT/JP01/00683 document. Therefore, the PCT document has been reasonably construed as not “an English copy” of document AQ. Further, the PCT/JP01/00683 document has not been considered because said document does not have a publication date.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

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9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 13, 16, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. The instant rejection has been necessitated by claim amendments.

12. Claim 13, line 2, recites the limitation of “sales based upon inventory...” in the preamble; however, the body of the claim does not recite any limitations which support the claimed method as directed to “sales based upon inventory...” Therefore, the metes and bounds of the instant claim are vague and indefinite because it is not clear whether the preamble or the body of the claim controls the metes and bounds of said claim. The same issue is present in claims 16 and 21.

### **CLAIM REJECTIONS - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 13, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US006456942B1) taken with Clontech Catalog (2000).

15. This rejection has been necessitated by the claim amendments.

#### **RESPONSE TO ARGUMENTS**

16. It is noted that the claim amendments have overcome the 35 U.S.C. 102(e)(2) rejection; therefore, said rejection has been withdrawn.

#### **BASIS FOR REJECTION**

17. Anderson discloses a method and network infrastructure for custom (setting arrangement of probes) microarray synthesis (production). The user submits a list of target sequences (order) of interest through a network server, the server designs a set of probes (specific base sequences), submit the list of probes to the synthesizer, the synthesizer builds the probes on the surface (individual areas) of an array, and the chip is shipped to the user (column 2, lines 53-67), as in instant claim 13, lines 1-9; claim 16, lines 1-8; and claim 21, lines 1-9.

18. Figures 2-6 provide screen shots of exemplary user interfaces for controlling and examining the status of DNA-synthesis equipment, chip-manipulation equipment (column 4, lines 40-45). Figure 4 displays a drawing of a chip represented in the graphical box labeled "chip state", the chamber number in which the DNA is being synthesized, the cycle number, the parameters (control conditions), and the sequence being built (column 5, lines 19-31), as in instant claim 13, lines 10-12; claim 16, lines 9-11, and claim 21, lines 10-11.

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19. Figure 3 demonstrates various functions that an operator can select from a computer interface program such as setting parameters used in synthesis and scheduling DNA sequences to build, and starting the DNA synthesis (confirmation), as in instant claim 13, lines 13-16; claim 16, lines 1-15; claim 21, lines 12-15.

20. However, Anderson does not describe a method and system as directed to sales, as in the amended claims 13, 16, and 21.

21. Clontech Catalog describes a method for accepting order and sales based upon inventory and specification information for a DNA chip. For example, the type of order information required by Clontech are catalog number, and size and quantity of product (Ordering Information page). Specific to DNA chip, the list of genes including accession number provided with each array is available at [atlas.clontech.com](http://atlas.clontech.com) (page 27, column 2).

22. Anderson describes that it would be useful for the computer to interface with equipment useful for biological and chemical processing and synthesis in a remote manner as directed to DNA chips (column 1, lines 39-41). Clontech describes a method of ordering DNA chips for research purpose wherein the DNA chip products are manufactured using a PCR equipment (page 27, column 2, Notice to Purchaser section).

23. An artisan of ordinary skill in the art at the time of the instant invention would have been motivated by the improvement described by Anderson to apply the usefulness of interfacing

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a computer with the DNA chip manufacturing equipment in a remote manner for the sales process as described by Clontech. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method and system for accepting order and sales as described by Anderson and Clontech.

### CONCLUSION

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

26. This application contains claims 14, 15, 17-20, and 22-24 drawn to an invention nonelected with traverse, April 19, 2004. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.



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27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547. The USPTO's official fax number is (571) 273-8300.

28. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

29. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on (571) 272-0718.

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C. Dune Ly

3/20/05

*Ash V. Marshall* 3/20/05  
[Stamp: JOHN A. MARSHALL, FEDERAL MARSHAL]